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09/622,137	08/11/2000	Michel Maillard	11345.023001	8272
22511	7590	10/25/2006	EXAMINER	
OSHA LIANG L.L.P. 1221 MCKINNEY STREET SUITE 2800 HOUSTON, TX 77010			HOFFMAN, BRANDON S	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 10/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/622,137

Applicant(s)

MAILLARD ET AL.

Examiner

Brandon S. Hoffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-20 and 30-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-20 and 30-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. Claims 4-20, and 30-36 are pending in this office action.
2. Applicant's arguments, filed August 24, 2006, have been fully considered but they are not persuasive.

### *Rejections*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 4-20 and 30-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 6,266,415 in view of Kamperman.

6. The independent claims of the instant application are the same as the above cited patent, in that both claims use a control word, from supplied scrambled data, to descramble data, and re-encrypting the descrambled data with a key. The claims differ in that the instant application further includes two different keys, one for re-encrypting and one for encrypting the first key. Kamperman shows this difference at column 6, lines 48-61.

#### ***Claim Rejections - 35 USC § 103***

7. Claims 4-8, 14-16, 30-32, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campinos et al. (U.S. Patent No. 6,266,415) in view of Kamperman (U.S. Patent No. 5,991,400).

Regarding claims 30, 31, and 34-36, Campinos et al. teaches a method/system/ recording support medium/receiver/decoder of recording transmitted digital data, comprising:

- **Receiving the transmitted digital data comprising scrambled data and encrypted transmitted digital information** (fig. 2, "I" transmitted to ref. num 7 and col. 1, lines 54-63);

- **Decrypting the encrypted transmitted digital information to obtain transmitted digital information, wherein the transmitted digital information comprises a control word, and wherein the control word is used to descramble the scrambled data** (fig. 2, ref. num 4 and col. 2, lines 4-9);
- **Re-encrypting the transmitted digital information using a recording encryption key** (fig. 2, ref. num 10 and col. 3, lines 10-18).

Campinos et al. does not teach storing the **re-encrypted transmitted digital information and the scrambled data** by a recording means on a recording support medium; encrypting the recording encryption key by a recording transport key; and storing the encrypted recording encryption key to the recording support medium, wherein at least one of the recording encryption key and recording transport key is stored on a portable security module associated with the recording means.

Kamperman teaches storing the **re-encrypted transmitted digital information and the scrambled data** by a recording means on a recording support medium (col. 5, lines 53-64); encrypting the recording encryption key by a recording transport key (col. 6, lines 48-61); and storing the encrypted recording encryption key to the recording support medium (col. 6, lines 54-57), wherein at least one of the recording encryption key and recording transport key is stored on a portable security module associated with the recording means (fig. 1, SCD, col. 5, lines 47-50, and col. 6, lines 38-41).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine storing the re-encrypted data and scrambled data on a medium and storing an encrypted recording encryption key on the medium, as taught by Kamperman, with the method of Campinos et al. It would have been obvious for such modifications because the data stored on the medium is securely stored on the set-top box for later viewing without the threat of having the data hacked and played on a different set-top box.

Regarding claim 4, Campinos et al. as modified by Kamperman teaches the transmitted information is encrypted prior to transmission and received by a decoder means before being communicated to the recording means (see fig. 1, TE, SCR, & RE, DSC of Kamperman).

Regarding claim 5, Campinos et al. as modified by Kamperman teaches the decoder is associated with a portable security module used to store transmission access control keys (KO (NS), KO' (Op1, NS) etc.) used to decrypt the transmitted encrypted information (see col. 5, lines 19-31 of Kamperman).

Regarding claim 6, Campinos et al. as modified by Kamperman teaches at least one of the recording encryption key (E (NE)) and/or recording transport key (RT (A)) function in accordance with a first encryption algorithm (DES) and the transmission access control keys (KO (NS), KO' (Op1, NS) etc.) function in accordance with a second

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encryption algorithm (CA) (see fig. 2A, the KRD is created differently than the AK of Kamperman).

Regarding claim 7, Campinos et al. as modified by Kamperman teaches the recording transport key (RT (A)) is generated at a central recording authorization unit and a copy of this key communicated to the recording means (see col. 6, lines 10-20 of Kamperman).

Regarding claim 8, Campinos et al. as modified by Kamperman teaches the recording transport key (RT (A)) is encrypted by a further encryption key (KO (NSIM)) prior to being communicated to the recording means (see col. 6, lines 48-57 of Kamperman).

Regarding claim 14, Campinos et al. as modified by Kamperman teaches:

- Using a decoder means and associated security module and a recording means and associated security module (see fig. 1, VTR, SCD, RE of Kamperman) and
- In which a copy of the recording transport key (RT (A)) is stored in at least one of the security module associated with the decoder means and/or the security module associated with the recording means (see col. 6, lines 54-57 of Kamperman).

Regarding claim 15, Campinos et al. as modified by Kamperman teaches the recording transport key (RT (A)) is generated by either the recording security modules or decoder security module and communicated to the other security module (see fig. 1, SCD sends the KRD to the VTR of Kamperman).

Regarding claim 16, Campinos et al. as modified by Kamperman teaches the recording transport key (RT (A)) is encrypted before communication to the other security module and decrypted by a key unique (KO (NS)) to that other security module (see col. 6, lines 48-56 of Kamperman).

Regarding claim 32, Campinos et al. as modified by Kamperman teaches further comprising a decoder means and associated security module adapted to store a copy of the recording transport key (RT(A)) (see fig. 1, VTR, SCR, RE of Kamperman).

Claims 9-13 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campinos et al. (USPN '400) in view of Kamperman (USPN '828), and further in view of Bednarek et al. (U.S. Patent No. 5,621,793).

Regarding claim 9, Campinos et al. as modified by Kamperman teaches all of the subject matter of claim 1, as discussed above. However, Campinos et al. as modified by Kamperman does not disclose a central access control system communicates



transmission access control keys (KO (NS), KO' (Op 1, NS) etc.) to the recording means.

Bednarek et al. teaches a central access control system communicates transmission access control keys (KO (NS), KO' (Op 1, NS) etc.) to the recording means (col. 8, line 61 through col. 9, line 13).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine a central access control system communicates keys to the recording means, as taught by Bednarek et al., to the method of Campinos et al./Kamperman. It would have been obvious for such modifications because the central access provides the keys needed for descrambling; this prevents tampering with the set-top box because the keys are not stored therein.

Regarding claim 10, Campinos et al. as modified by Kamperman/Bednarek et al. teaches the transmission access control keys (KO (NS), KO' (Op1, NS) etc.) are communicated to a portable security module associated with the recording means (see col. 13, lines 31-51 of Bednarek et al.).

Regarding claims 11 and 33, Campinos et al. as modified by Kamperman/Bednarek et al. teaches the recording means directly descrambles transmitted information using the transmission access keys (KO (NS), KO' (Op1, NS)

etc.) prior to re-encryption of the information by the recording encryption key (E (NE)) and storage on the support medium (see fig. 2, ref. num 46 of Bednarek et al.).

Regarding claim 12, Campinos et al. as modified by Kamperman/Bednarek et al. teaches central access control system encrypts the broadcast access control keys (KO (NS), KO' (Op1, NS) etc.) by a further encryption key (KO (NSIM)) prior to their communication to the recording means (see col. 6, lines 28-60 of Bednarek et al.).

Regarding claim 13, Campinos et al. as modified by Kamperman/Bednarek et al. teaches the recording means sends a request to the central access control system including information identifying the broadcast access keys needed (KO (NS), KO' (Op1, NS) etc.), the request being authenticated by the recording means using a key (KO (NSIM)) unique to that recording means (see col. 5, lines 19-34 of Bednarek et al.).

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Campinos et al. (USPN '400) in view of Kamperman (USPN '828), and further in view of Park (European Patent No. 714204).

Regarding claim 17, Campinos et al. as modified by Kamperman teaches all of the subject matter of claims 1 and 14-16, as discussed above. However, Campinos et al. as modified by Kamperman does not disclose the decoder security module and recording security module (52) carry out a mutual authorization process, the unique

decryption key (KO (NS)) being passed to the other security module from the encrypting security module depending on the results of the mutual authorization.

Park teaches the decoder security module and recording security module (52) carry out a mutual authorization process, the unique decryption key (KO (NS)) being passed to the other security module from the encrypting security module depending on the results of the mutual authorization (page 8, lines 43-45).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine mutual authorization between the security module and recording module, as taught by Park, to the method of Campinos et al./Kamperman. It would have been obvious for such modifications because mutual authorization ensures integrity between the two devices.

Regarding claim 18, Campinos et al. as modified by Kamperman/Park teaches the mutual authorization step is carried out using, inter alia, an audience key KI (C) known to both security modules (30,52) (see page 8, lines 39-42 of Park).

Regarding claim 19, Campinos et al. as modified by Kamperman teaches all of the subject matter of claims 1 and 14, as discussed above. However, Campinos et al. as modified by Kamperman does not disclose the decoder security module possesses transmission access control keys (KO (NS), KO' (Op1, NS) etc.) to decrypt the

transmitted information in an encrypted form and a session key (K3 (NSIM)) to re-encrypt the information prior to communication to the recording security module, the recording security module possessing an equivalent of the session key (K3 (NSIM)) to decrypt the information prior to encryption by the recording transport key (RT (A)).

Park teaches:

- The decoder security module possesses transmission access control keys (KO (NS), KO' (Op1, NS) etc.) to decrypt the transmitted information in an encrypted form (page 8, lines 10-19) and
- A session key (K3 (NSIM)) to re-encrypt the information prior to communication to the recording security module, the recording security module possessing an equivalent of the session key (K3 (NSIM)) to decrypt the information prior to encryption by the recording transport key (RT (A)) (page 8, lines 20-22).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine the decoder security module possessing transmission access control keys to decrypt the transmitted information in an encrypted form and a session key to re-encrypt the information prior to communication to the recording security module, the recording security module possessing an equivalent of the session key to decrypt the information prior to encryption by the recording transport key, as taught by Park, to the method of Campinos et al./Kamperman. It would have been obvious for such modifications because the decoder security module possessing

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transmission access control keys to decrypt the transmitted information in an encrypted form would allow the security module to properly decrypt the encrypted data for proper restoration of the signal. Also, a session key to re-encrypt the information prior to communication to the recording security module, the recording security module possessing an equivalent of the session key to decrypt the information prior to encryption by the recording transport key would secure the clear signal again before transmission to the recording device, thus making the secure digital recording device more secure.

Regarding claim 20, Campinos et al. as modified by Kamperman/Park teaches the session key (K3 (NSIM)) is generated by one of the decoder security module or recording means security module and communicated to the other module in encrypted form using an encryption key (KO (NS)) uniquely decryptable by the other security module (see page 8, lines 20-22 of Park).

### ***Response to Arguments***

8. Applicant's arguments are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon S. Hoffman whose telephone number is 571-272-3863. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser G. Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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